

Hearing: 9/5/01
June 7, 2001

THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.

Paper No. 32
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Celotex Corporation
v.
Cellux Converters, Inc.

Opposition No. 109,080
to application Serial No. 75/191,597
filed on November 1, 1996

David W. Pettis, Jr. of Pettis & Van Royen, P.A. for
Celotex Corporation.

Cellux Converters, Inc., pro se.¹

Before Quinn, Hohein and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

¹ Applicant was represented before the USPTO by the same attorney and law firm from the filing of its application in November 1996 through the oral hearing held on June 7, 2001. However, on May 30, 2001, or about one week prior to the scheduled oral hearing date, applicant's attorney had filed a motion to withdraw as counsel. Due to possible prejudice to applicant, the Board deferred a decision on the request to withdraw until after the oral hearing. Following the oral hearing (at which applicant's attorney appeared), applicant's attorney's motion to withdraw as counsel was granted by the Board in an order dated June 14, 2001. Thus, applicant is now pro se, and applicant's copy of this order will be mailed only to applicant, and it will not be mailed to applicant's previous attorney.

Cellux Converters, Inc. filed an application to register the mark CELLOTEC on the Principal Register for "adhesive tape for stationery or household purposes" in International Class 16, and "adhesive packing tape for sealing cartons for industrial or commercial use" in International Class 17.²

Celotex Corporation has opposed registration of the mark (in both classes) alleging that opposer owns nine registrations for the mark CELOTEX all appearing in either one or the other of the two design forms shown below

³ and

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² Application Serial No. 75/191,597, filed November 1, 1996, based on applicant's allegation of a bona fide intention to use the mark in commerce.

³ Registration No. 167,860, issued May 8, 1923, for "composition of material for wall boards, linings for houses, and heat-insulating lumber," republished in 1948, Section 8 affidavit accepted, Section 15 affidavit acknowledged, third renewal;

Registration No. 395,899, issued June 16, 1942, for a variety of asphalts, pitches, gypsums, and landplasters, second renewal;

Registration No. 401,741, issued June 8, 1943, for various cements comprising an asphalt base for adhering construction materials, second renewal;

Registration No. 408,163, issued July 25, 1944, for "paints and painters' materials, namely, asphalt roof paint, asbestos roof paint, and paints having an asphalt and/or coal tar base," second renewal;

Registration No. 517,361, issued November 8, 1949, for "composition of material for wall boards, linings for houses," Section 8 affidavit accepted, Section 15 affidavit acknowledged, second renewal. (This registration, however, expired in 2000

all for goods related to those of applicant; that opposer commenced use of the mark CELOTEX on adhesive tape

for failure to file a further renewal and will not be given further consideration.);

Registration No. 528,607, issued August 8, 1950, for "fiber insulation board, in its various forms identified as insulating wallboard, insulating sheathing, tile, and the like in accordance with the end use of the goods," Section 8 affidavit accepted, Section 15 affidavit acknowledged, second renewal. (This registration, however, just expired in 2001 for failure to file a further renewal and will not be given further consideration.); and

Registration No. 556,165, issued March 18, 1952, for "composition of material for wall boards in board or sheet form and used as linings for houses, box-making material, fiberboard suitably saturated with, coated and/or processed, namely, sound absorbing tile, insulating brick siding and siding boards; fiber hardboard; asphalt shingles, siding, and roll roofing; gypsum plasters, wall boards, plasterboard, and lath; and tile mounting systems, namely, metal retaining strips, splines, and miniature beams for the erection of prefabricated tile," Section 8 affidavit accepted, Section 15 affidavit acknowledged, second renewal.

⁴ Registration No. 984,290, issued May 21, 1974, for "gypsum sheathing, gypsum wallboard, mineral fiber acoustical lay-in panels, mineral fiber acoustical tile, urethane insulation, asphalt shingles, roll roofing, fiberboard acoustical tile, fiber building board, fiberboard sheathing, asphalt coated sheathing, fiberboard ceiling tile, metal grid parts, fiberboard lay-in panels, concrete joint filler, roof insulation, vapor barrier base sheet and insulating siding" (International Class 6) and "electrical lighting fixtures" (International Class 11), Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed; and

Registration No. 1,142,164, issued December 9, 1980, for "plastic adhesives for general construction use" (International Class 1), "asphalt coatings for general purpose use on metal, wood, composition roofing, and concrete" (International Class 2), "asphalt emulsions for use as general protective coatings for masonry, metal, wood, and the like; asphalt primers for priming metal, concrete, masonry, and other surfaces prior to application of hot roofing or waterproofing asphalts; construction cements; joint system cement compound" (International Class 19), Section 8 affidavit accepted, Section 15 affidavit acknowledged. (A renewal was due on this registration by June 9, 2001, but there is no record of same

products prior to the filing date of applicant's application; that opposer's registered and unregistered marks (CELOTEX in stylized lettering) have become well known as identifying opposer as the source of insulation products and adhesives; and that applicant's mark, if used in connection with its goods, would so resemble opposer's previously used and registered marks as to be likely to cause confusion, mistake, or deception.⁵

Applicant, stating in its answer that it was without information to form a belief as to the truth thereof, has therefore denied each of the salient allegations of the notice of opposition.

being filed with the USPTO. Accordingly, this registration will not be given further consideration.)

⁵ Opposer's original notice of opposition also included the wording "and to dilute the value and source identifying power of Opposer's marks...." (See paragraphs 2, 4 and 5.) At the time the notice of opposition was filed, the Board had no authority under the Trademark Act to determine the issue of dilution. However, after the close of trial and completion of the briefing of this case, the Trademark Act was amended, and opposer filed a motion to amend the pleading to include a dilution claim. (The only change in opposer's proposed amended notice of opposition was an inclusion of a citation to the Trademarks Amendments Act of 1999.) In an order dated April 19, 2001, the Board deferred a decision of both opposer's motion to amend the pleading and opposer's motion to strike applicant's brief filed in response to the motion to amend. Having now reviewed the entire record, opposer's motion to amend the pleading is denied because the issue of dilution was not tried. See Fed. R. Civ. P. 15(b). Opposer's motion to strike applicant's brief in opposition to the motion to amend is also denied.

We recognize that opposer's amendment to the pleading was merely the addition of a statutory citation; but even with regard to the original pleading, the necessary elements of a

The record consists of the pleadings; the file of the opposed application; status and title copies of opposer's nine pleaded registrations which accompanied the original notice of opposition pursuant to Trademark Rule 2.122(d)(1); the declaration testimony, with one exhibit, of E. H. Fuhs, opposer's product manager⁶; and opposer's notice of reliance on applicant's responses to opposer's first and second sets of interrogatories and document requests, and on opposer's first set of requests for admissions, to which applicant failed to respond. Applicant took no testimony and offered no evidence during its testimony period. Both parties filed briefs on the case. An oral hearing was held before the Board on June 7, 2001.

With regard to the issue of priority in relation to the goods set forth in opposer's pleaded registrations, to the extent that opposer owns valid and subsisting registrations of its pleaded marks, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974);

proper dilution claim were neither pleaded nor proven in this case.

⁶ Opposer indicated that applicant's attorney stipulated to the submission. Informationally, opposer is advised that Trademark Rule 2.123(b) has been amended to require the written agreement of the parties to testimony so submitted.

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and Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995).

With regard to the issue of priority in relation to opposer's claim of common law rights in the mark CELOTEX (in stylized lettering with a line under the word and connecting the letter "C" and the letter "X") for adhesive tape "primarily intended for use in combination with [opposer's] foam board products" (Fuhs declaration), opposer's evidence establishes its continuous use thereon since 1985, which is well prior to applicant's filing date of November 1, 1996. In applicant's June 24, 1998 answers to opposer's interrogatories applicant answered regarding its first use of the mark on adhesive tape as follows:

"Applicant has not used the Mark in connection with any rolls of tape at the present time. All shipments up to this point have been made as plain core/carton." (Answer to interrogatory No. 9); and

"There have been no sales of tape, whereby the Mark has been used to identify the product." (Answer to interrogatory No. 10).

Opposer has established its priority with regard to common law rights in the mark CELOTEX (stylized) for adhesive tape primarily intended for use with opposer's foam board products.

Thus, the only remaining issue before the Board is likelihood of confusion. Our determination of likelihood of confusion must be based on our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Based on the record before us in this case, we find that confusion is likely.

We turn first to consideration of the similarities or dissimilarities of the marks. Applicant argues that its mark CELLOTEC appears in typed form, whereas opposer's marks (registered and common law) show the word CELOTEX in special forms; that there are two "L"s in applicant's mark but only one "L" in opposer's mark; and that applicant's mark ends in "C" while opposer's mark ends in "X."

While the differences described by applicant are accurate, we nonetheless find that these marks, CELLOTEC and CELOTEX (in various stylized lettering) are similar in sound, appearance, connotation and commercial impression. There is nothing in the record to indicate that the marks are anything other than arbitrary in meaning in relation to the goods. Both marks begin with "CELLO" or "CELO" and end in "TEC" or "TEX." The

difference of one letter "L" is not significant; the ending letters "C" and "X" sound like the singular or plural of the same term; and the stylized lettering in opposer's mark does not offer sufficient differences to create a separate and distinct commercial impression. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Moreover, the differences in the marks may not be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992); and *Edison Brothers Stores v. Brutting E.B. Sport-International*, 230 USPQ 530 (TTAB 1986).

Even if purchasers specifically realize that there are some differences between the involved marks, they may

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believe that applicant's mark is simply a revised version of opposer's mark, with both serving to indicate origin in the same source. Opposer's mark has been registered for almost eighty years, and a purchaser familiar with opposer's goods sold under the mark CELOTEX may, upon seeing applicant's mark on these related goods, assume that applicant's goods come from the same source as opposer's goods.

Thus, we find these marks are similar in sound, appearance, meaning and commercial impression.

Turning to the du Pont factor of the fame of opposer's mark, applicant failed to respond to opposer's request for admission No. 4 that applicant admit that opposer's CELOTEX mark is famous and, therefore, applicant is deemed to have admitted same pursuant to Fed. R. Civ. P. 36. (Applicant does not argue otherwise in this case.) This record establishes that opposer's mark CELOTEX is famous. The fame of opposer's mark increases the likelihood that consumers will believe that applicant's goods emanate from or are sponsored by the same source. See *Recot Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys Inc. v. Rose Art Industries Inc.* 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Turning next to consideration of the parties' respective goods, it is well settled that goods (and/or services) need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead that the goods (and/or services) are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); and *In re International Telephone and Telegraph Corporation*, 197 USPQ 910 (TTAB 1978).

Further, it has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods (and/or services) as identified in the application with the goods (and/or services) as identified in the registration(s). See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Applicant's goods are identified as "adhesive tape for stationery or household purposes" in International Class 16, and "adhesive packing tape for sealing cartons for industrial or commercial use" in International Class 17. With respect to opposer's registered mark, CELOTEX (in stylized lettering), the identified goods include "box making material" (Registration No. 556,165), and opposer's goods on which it has established prior common law rights in the mark are adhesive tape "primarily" (though not solely) intended for use with opposer's foam board products. We find that there is a commercially significant relationship between opposer's adhesive tape used with its foam board products and its box-making materials, on the one hand, and applicant's adhesive packing tape for sealing cartons for commercial and industrial tape, on the other hand. Moreover, even applicant's general household adhesive tape is a related product, albeit for a different purpose, to the aforementioned goods of opposer. Opposer sells box-making material, and applicant intends to sell an adhesive packing tape for sealing cartons. Opposer sells an adhesive tape with the "primary" (but not the sole) purpose of use with opposer's wallboard products, but

according to applicant, it "uses⁷ its mark on dozens of types of adhesive tapes in the general market. Applicant sells adhesive tape for medical applications, graphic arts/picture framing, *industrial uses*, carpet installation and office and consumer tape." (Brief, p. 6.) (Emphasis added.) Given the wide variety of adhesive tapes covered by applicant's identifications of goods, and especially with regard to those for industrial uses, opposer's adhesive tape could be encompassed within applicant's goods.

Applicant strongly urges that the goods are not sold in the same trade channels to the same classes of purchasers. It is true that there is little evidence on this point;

however, when we consider the goods on which applicant asserts a bona fide intention to use the mark as identified in the application, as we must, it is not limited in any way so as to preclude overlap in the industrial or commercial markets in which opposer's mark is involved. Therefore, applicant's identification of goods encompasses adhesive tapes for household use and a specific adhesive packing tape for sealing cartons for

⁷ Based on this statement by applicant's attorney, we presume that applicant has commenced actual use of the mark CELLOTEC on the applied-for goods.

commercial and industrial uses which would be sold through all normal channels of trade to all the usual purchasers for those goods. See Octocom Systems Inc. v. Houston Computer Services Inc., supra, at 1787; and The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991).

We find applicant's goods are closely related to opposer's common law goods, and they are overlapping or complementary to certain of opposer's registered goods, most notably, "box-making material"; and that the parties' goods would be sold in similar channels of trade to the same purchasers.

Another du Pont factor to be considered in the case now before us is "the variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark)." In re E. I. du Pont de Nemours & Co., supra, at 567. Opposer has registered the mark CELOTEX for a variety of products regularly used in household, commercial and industrial applications, including compositions of material for wall boards, box-making material, asphalts, pitches, landplasters, cements, certain roof paints, tile mounting systems, fiberboard, insulation, heat insulating lumber, roofing, sheathing, insulation siding and metal grid parts. Further, the

record is clear that opposer currently sells and for many years has sold an adhesive tape used in connection with opposer's foam board products. Purchasers aware of the variety of opposer's goods sold under the mark CELOTEX may well assume that opposer is now offering adhesive tape for household use and/or adhesive packing tape for sealing cartons for industrial use under the mark CELLOTEC. See *Uncle Ben's Inc. v. Stubenberg International Inc.*, 47 USPQ2d 1310, 1313 (TTAB 1998).

Accordingly, because of the similarity of the parties' marks; the fame of opposer's mark; the relatedness of some of the parties' goods and the overlapping or complementary nature of other goods; the overlapping trade channels and similar purchasers; and the variety of goods on which opposer has used and registered its mark, we find that there is a likelihood that the purchasing public would be confused if applicant uses CELLOTEC as a mark for its adhesive tape for stationery and household purposes and adhesive packing tape for sealing cartons for industrial and commercial use.

Applicant, as the newcomer, had the obligation to select a mark which would avoid confusion. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025

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(Fed. Cir. 1988); and Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993).

Decision: The opposition is sustained, and registration to applicant is refused.